

Remarks

Applicant appreciates the Examiner's careful review of the application and submits the following remarks in support of the patentability of the pending claims.

The Informalities Have Been Addressed

Regarding the Examiner's objection to the drawings, FIG. 3 has been replaced and now is shown enclosed in brackets.

Additionally, the specification has been corrected by submission of three replacement paragraphs. On page 6, line 2, a typographical error in the word "therein" has been fixed.

Finally, claim 2 has been amended to insert the missing "the" in the first line, clearly an unintended typographical omission.

For those reasons, Applicant respectfully requests withdrawal of these objections.

Claim 4 Is Enabled Under Section 112

The Examiner expressed concern that claim 4 failed to comply with the enablement requirement under 35 USC 112. Claim 4 was, therefore, rejected on those grounds. Applicant has amended the specification so that "the skilled will appreciate the adjustability of the angle of the base member connector 2-7 by noting the engagement relationship between knob 2 and base member 1, as shown in FIGS. 1 and 2." Applicant believes that, between the statement in the specification and the disclosure in the drawings, the skilled will have no difficulty discerning how this connection produces an adjustable feature. Certainly, the skilled will not be required to undergo "undue" experimentation to arrive at this structural feature of the invention. Accordingly, Applicant respectfully requests withdrawal of this rejection.

The Claims Recite A Novel Invention Over The Cited Art

The Examiner has rejected all three pending independent claims, claims 1, 9 and 36, as anticipated by and unpatentable under 35 USC 102 in view of WO 96/26691 by Siana. Applicant respectfully disagrees for the following reasons.

First, on page 8, section 10, of the Office action, the Examiner recognizes that the Siana reference "fails to teach the apparatus of claim 1, wherein said plurality of extension members comprises individual extension members having different lengths. Instead, Siana teaches an equivalent configuration including adjustment means, which allows length adjustment of the connectors in order to properly size the apparatus."

With that in mind, Applicant has amended claim 1 to recite that the one or more extension members have predetermined lengths. In contrast, the Siana apparatus does not describe or even suggest individual extension members of a given length. Because the Siana apparatus depends on connecting members which must be adjusted to make them shorter or longer, the invention is at least difficult to use and possibly even dangerous to the patient, for example, if the two extendable connectors are unevenly adjusted so that they are not exactly matched in length, this may induce uneven extensions along the opposing lateral peripheries of the patient's penis, resulting in formation of an undesirable bend. The presently claimed apparatus overcomes this dangerous deficiency in the cited reference by providing extension members of predetermined lengths; therefore, to avoid a bend, all the patient needs do is to use matching extension members on both sides. Siana fails to even recognize this shortcoming in her apparatus and, thus, cannot be said to anticipate or even make the invention recited in claim 1 obvious. Independent claims 9 and 36 have been similarly amended to recite extension members of predetermined lengths.

Since the Examiner has already recognized that Siana fails to teach extension members having different lengths and, hence, being of predetermined lengths, the amended claims should now more clearly define over the cited reference. Therefore, Applicant respectfully requests that the anticipation rejection of the independent claims be withdrawn.

The Claims Recite A Nonobvious Invention Over The Cited Art

The Examiner did not reject any independent claim as obvious and unpatentable under 35 USC 103 in view of the cited art by Siana.

Since Applicant has shown how the independent claims define over the cited art and since the Examiner has recognized that Siana fails to teach individual extension members having different lengths, Applicant suggests the pending independent claims recite an invention which is nonobvious over the Siana reference.

It is established that dependent claims which recite further distinguishing features beyond their respective independent claims will be deemed patentable once the independent claims are found to be patentable.

Therefore, because all pending independent claims appear to be novel and nonobvious over the cited art, Applicant suggests that all pending claims should be allowable.

Conclusion

For the reasons set forth above, Applicant believes the pending claims are patentable over the cited art and respectfully requests that the Examiner issue a Notice of Allowance in this application.

In re Patent Application of
Gomez-de-Diego
Serial No. 10/829,006
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If further prosecution may be aided by a conference, Applicant respectfully requests that counsel be contacted by telephone at the Examiner's convenience.

Respectfully submitted,

/ENRIQUE G. ESTEVEZ/
Enrique G. Estévez
Reg. No. 37,823
Allen, Dyer, Doppelt, Milbrath & Gilchrist, P.A.
255 S. Orange Ave., Suite 1401
P. O. Box 3791
Orlando, Florida 32802
(407) 841-2330